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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,665	01/26/2004	Kaoru Taneichi	F-8120	8787
28107	7590	06/22/2006	EXAMINER	
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			SAETHER, FLEMMING	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/764,665	TANEICHI, KAORU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Flemming Saether	3677	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6,8,9 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,8 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Election Restriction***

Claims 4 and 9 remain in the application as withdrawn.

***Claim Objections***

Claims 5 and 8 are objected to because in each of the claims, the outward deformation has been previously defined and as such should not be referred to by "an outward deformation" but instead as --the outward deformation--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11,13 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nalle (US 3,104,493). Nalle discloses a fastener (13) in combination with an attachment member (14) having a receiving hole (18); the nut includes an attachment part (21) being freely received in the receiving hole and a plurality of fitting pieces (22), which are capable of outward deformation, for retaining the attachment part within the hole and the nut to the attachment member. The attachment part has a smaller outside diameter than an inside diameter of the receiving hole (the sentence bridging columns 2 and 3) and a portion of the nut body adjacent the attachment part abuts the attachment member (at member 16). The fitting pieces are formed as four circumferentially spaced

arcuate members having an arc of approximately 90° and separated by a distance less than the length of the arc.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, 8 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nalle in view of Weddendorf (US 5,340,252). Nalle discloses a fastener (13) in combination with an attachment member (14) having a receiving hole (18); the nut includes an attachment part (21) being freely received in the receiving hole and a plurality of fitting pieces (22), which are capable of outward deformation, for retaining the attachment part within the hole and the nut to the attachment member. The attachment part has a smaller outside diameter than an inside diameter of the receiving hole (the sentence bridging columns 2 and 3) and a portion of the nut body adjacent the attachment part abuts the attachment member (at member 16). The fitting pieces are formed as four circumferentially spaced arcuate members having an arc of approximately 90° and separated by a distance less than the length of the arc. Nalle does not disclose the nut as a quick connect nut. Weddendorf discloses a quick connect nut comprising a hexagonal exterior, an inner conical portion (26) including guideposts (57) receiving a plurality of nut segments (41), a stop flange (36) having an

aperture and, a spring biasing the nut segments. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to make the nut of Nalle a quick connect nut as disclosed in Weddendorf in order to quicken the adjustment of the nut onto the post in Nalle. The skilled artisan would find the quicker adjustment advantageous since it would speed the assembly and adjustment of the support element to the proper position by allowing for the nut to be simply pushed into the desired position thus saving time over the nut having to be rotated. The outward deformation of the fitting pieces after insertion is a product-by-process limitation of modified Nalle would be capable and, the loss of tightening power would also inherently be inhibited by the spring.

Claims 2, 3, 5, 6 and 8 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Meredith (US 5,655,936) in view of Weddendorf (US 5,340,252) and further in view of Mehlberg (US 5,842,894). Meredith discloses a fastener (16) in combination with an attachment member (18) having a receiving hole (28); the nut includes an attachment part (24) being freely received in the receiving hole and a fitting part (30) which is deformed outward (Figs. 3-5) for retaining the attachment part within the hole and the nut to the attachment member. The attachment part has a smaller outside diameter than an inside diameter of the receiving hole (column 2, lines 39-42) and a portion of the nut body adjacent the attachment part abuts the attachment member (see Figs. 5 and 6). Meredith does not disclose the nut as a quick connect nut. Weddendorf discloses a quick connect nut comprising a hexagonal exterior, an inner

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conical portion (26) including guideposts (57) receiving a plurality of nut segments (41), a stop flange (36) having an aperture and, a spring biasing the nut segments. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to make the nut of Meredith a quick connect nut as disclosed in Weddendorf in order to quicken the attachment of the nut onto the terminal post in Weddendorf. The skilled artisan would find the quicker advantageous since it would speed the assembly of the battery cable to the battery terminal by allowing for the cable connector to be simply pushed onto the terminal. Meredith, even as modified by Weddendorf, does not disclose the plurality of fitting pieces. Mehlberg discloses a fastener (1) in combination with an attachment member (8) which are secured together and teaches the equivalence of the securement being provided as a single fitting piece or a plurality of fitting pieces (column 3, line 30-31). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the single fitting piece of Meredith with a plurality of fitting pieces in view of the Mehlberg's teaching that a single and plural fitting pieces are recognized equivalents. Once the combination was made, the spring inherently would automatically inhibit loss of tightening power due to an axial shift of the bolt.

***Response to Remarks***

In regards to the requirement that in response to final the non-elected claims be canceled did in fact not require the cancellation but instead left open "other appropriate action". (37 CFR 1.144) See MPEP § 821.01.

The 112 rejections have been obviated by the amendment however; a claim objection has been introduced as noted above.

In regards to the rejection based on the combination of Nalle and Weddendorf, applicant argues that neither reference discloses a fitting pieces extending outward as a result of outward deformation applied after insertion into the receiving hole as well as the automatic protection against loss of tightening power as a result of an axial shift of the bolt. In response, the examiner disagrees because first, the outward deformation after the insertion is a product-by-process limitation wherein it is only the final product which is considered for patent and second, once the references are combined the structure would be the same as that claimed and as such the automatic protection against loss of tightening power would be inherent.

In regards to rejection based on the combination of Meredith, Weddendorf and Mehlberg, applicant argues that there is nothing contained within the reference which would suggest combining the references to prevent the axial movement and the loss of tightening power. In response, the references need not be combined for the purpose of

solving the same problem which applicant is concerned. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Flemming Saether  
Primary Examiner  
Art Unit 3677